Hovsepian v. Apple, Inc. Doc. 294

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

In Re ACACIA MEDIA TECHNOLOGIES CORPORATION	)	Case No. C-05-01114JW **[PROPOSED] ORDER GRANTING ROUND 3 DEFENDANTS' MOTIONS FOR SUMMARY JUDGMENT OF INVALIDITY UNDER 35 U.S.C. § 112 OF THE '992, '863 AND '702 PATENTS**

On ______________, 2009, the Motions for Summary Judgment of Invalidity under 35 U.S.C. § 112 of the Round 3 Defendants (Time Warner Inc. and CSC Holdings, Inc.) were heard. The Round 3 Defendants seek an order declaring claims 41, 45 and 46 of the asserted U.S. Patent No. 5,132,992, claims 17-19 of the asserted U.S. Patent No. 5,550,863, and claims 1-42 of the asserted U.S. Patent No. 6,144,702 invalid for failure to comply with the written description, enablement, and/or definiteness requirements of 35 U.S.C. § 112.

After considering the materials and oral argument presented by the parties, and good cause appearing:

IT IS HEREBY ORDERED that Defendants' motions are GRANTED. Defendants have shown that there are no genuine issues of material fact and that they are entitled to judgment as a matter of law that asserted claims 41, 45 and 46 of U.S. Patent No. 5,132,992, asserted claims 17-19 of U.S. Patent No. 5,550,863 and asserted claims 1-42 of U.S. Patent No. 6,144,702 (collectively, the "Asserted Claims") are invalid under 35 U.S.C. § 112 for the following reasons:

1. Each Asserted Claim is invalid under 35 U.S.C. § 112 because "transmission system" is not adequately described or enabled;

2. Claims 1-42 of U.S. Patent No. 6,144,702 and claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because the "reception system" of claims 1-42 of U.S.

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Patent No. 6,144,702 and the “local distribution system” of claims 17-19 of U.S. Patent No. 5,550,863 are not adequately described or enabled;

3. Claims 41, 45 and 46 of U.S. Patent No. 5,132,992 and claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because the “sequence of addressable data blocks” of these claims is not adequately described or enabled;

4. Claims 41 and 45 of U.S. Patent No. 5,132,992 and claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because a method of transmitting information that is not responsive to user requests is not adequately described or enabled, and because by claiming such a method the applicants failed to satisfy the requirement of 35 U.S.C. § 112 ¶ 2 that they claim only what they regard as their invention;

5. Claims 41, 45 and 46 of U.S. Patent No. 5,132,992 are invalid under 35 U.S.C. § 112 because a method of transmitting information to “remote locations” that do not have a receiving system is not adequately described or enabled and because by claiming such a method the applicants failed to satisfy the requirement of 35 U.S.C. § 112 ¶ 2 that they claim only what they regard as their invention;

6. Claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because a method of transmitting information to a reception system without storing compressed data in the transmission system prior to transmission is not adequately described or enabled;

7. Claim 46 of U.S. Patent No. 5,132,992 is invalid under 35 U.S.C. § 112 because a method that does not require that “requests from users” identify the reception system to which the information is to be sent is not adequately described or enabled;

8. Claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because “inputting an item having information into the transmission system” is not adequately described or enabled;

9. Claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because "assigning a unique identification code to the item having information" is not adequately described or enabled;

10. Claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because a method using a "receiving system" that is "local" with respect to a "subscriber receiving station" is not adequately described or enabled, and because the term "local" is indefinite;

11. Claims 41, 45 and 46 of U.S. Patent No. 5,132,992 are invalid under 35 U.S.C. § 112 because "storing items having information in a source material library" is not adequately described or enabled;

12. Claims 41, 45 and 46 of U.S. Patent No. 5,132,992 are invalid under 35 U.S.C. § 112 because "retrieving the information in the items from the source material library" is not adequately described or enabled;

13. Claim 46 of U.S. Patent No. 5,132,992 is invalid under 35 U.S.C. § 112 because "generating a listing of available items" in claim 46 is not adequately described or enabled;

14. Each Asserted Claim is invalid under 35 U.S.C. § 112 as indefinite because require it requires an "identification encoder";

15. Claims 1-26 and 32-33 of U.S. Patent No. 6,144,702 are invalid under 35 U.S.C. § 112 as indefinite because they contain the term "sequence encoder";

16. Claims 17-19 of U.S. Patent No. 5,550,863 are invalid under 35 U.S.C. § 112 because the step of transmitting "to at a plurality of receiving stations" is indefinite;

17. Claims 41, 45 and 46 of U.S. Patent No. 5,132,992 are invalid under 35 U.S.C. § 112 as indefinite because the steps of the claims can never be completed;

18. Claims 45 and 46 of U.S. Patent No. 5,132,992 are invalid under 35 U.S.C. § 112 as indefinite because claim 45's requirement of "separately storing a plurality of files" is inconsistent with claim 41 from which it depends; and

19. Claim 46 of U.S. Patent No. 5,132,992 is invalid under 35 U.S.C. § 112 as indefinite because claim 46's requirement of retrieving data blocks corresponding to "requests" from "users" is inconsistent with claim 41 from which it indirectly depends.

IT IS SO ORDERED.

Dated: ______________, 2009.

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JAMES WARE
United States District Judge